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Withers, and Keys LLC
PO Box 71355
Marietta, GA 30007-1355

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| EXAMINER |
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STERRETT, JONATHAN G

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| ART UNIT | PAPER NUMBER |
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3623

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|----------------------------------------|------------|---------------|
| 3 MONTHS | 02/12/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/577,658

Applicant(s)

OWEN ET AL.

Examiner

Jonathan G. Sterrett

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6, 9-11, 23, 27 and 29-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6, 9-11, 23, 27 and 29-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Summary

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 15 November 2006 has been entered.

2. This **Non-Final Office Action** is responsive to applicant's amendment filed 15 November 2006. Currently **Claims 2-6, 9-11, 23, 27 and 29-32** are pending.

Response to Arguments

3. The applicant's arguments have been fully considered regarding **Claims 2-6, 9-11, 23, 27 and 29-32**, but they are not persuasive.

4. The applicant argues on page 16 with regards to Claims 31 and 32 that Melchione fails to teach the claimed limitations of storing into a database that a particular entity does not wish to be contacted.

The examiner respectfully disagrees.

Melchione teaches a database for tracking customer preferences. Melchione notes that when a particular organization becomes large, it becomes difficult to manage the information for a large number of customers. Melchione

Art Unit: 3623

teaches addressing this need by, inter alia, providing for storing of 'do not call' information where the customer is not called, i.e. contacted. This is functionally the same as storing information where an entity does not wish to be contacted, i.e. called.

The remainder of the applicants arguments are moot in view of new grounds of rejection. Please see the 35 USC 103(a) rejections below.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 2-6, 9-11, 23, 27 and 30-32** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **Claims 27 and 30** the limitations cite generating a report that is utilized to track sales activities, compare performance and to determine which entities should be contacted and in what order. However, the claim does not cite how this utilization occurs and it is not clear how a report which tracks activities and compares performance can also determine which entities should be contacted and in what order, thus the claim is indefinite.

Claim 23 is cited as depending on **Claim 29**, however **Claim 29** has been canceled and thus the claim is indefinite.

Art Unit: 3623

Claim 9 depends on **Claim 27** and cites a 'printout'. However, this limitation (a 'printout') has been removed from **Claim 27** and thus there is no antecedent basis for this 'printout' in **Claim 9**.

Claims 2-6, 9-11, 23 and 30-32 are indefinite at least for the reasons cited above for independent **Claims 27 and 30**.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-6, 9-11, 23, 27 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Upshot software product in view of Melchione et al. (U.S. Patent 5,930,764).

The Upshot software product is detailed in the following references:

"Upshot Sales Features List", pp.1-2, web.archive.org webpage of Feb 21, 1999, hereinafter **Upshot A**.

"Upshot: Use the Coolest Stuff", pp.1-2, web.archive.org webpage of Feb 24, 1999, hereinafter **Upshot A**.

"Upshot: Be Sales-Focused", pp.1-2, web.archive.org webpage of Feb 24, 1999, hereinafter **Upshot C**.

Art Unit: 3623

PRNewswire, "Upshot® Sales Goes 'Unplugged'", April 12, 1999, pp.1-2, hereinafter **Upshot D**.

Regarding **Claim 27**, Upshot teaches a method for retaining and using contact information, comprising:

receiving a first item of contact information from one of a plurality of sales representatives via a graphical user interface ("GUI") displayed on a computer executing a software application;

Upshot D, Page 1 para 2 section A, users can receive contact information from a computer program running on their laptop. The Upshot interface provides users with a GUI so that they can access their sales information while traveling and upload sales information while they are offline.

storing the first item of contact information in at least one searchable database in communication with the computer and associating the first item of contact information with a particular entity;

Upshot D, page 1 para 1, the Upshot software uses a database for storing sales information; para 2, the account information for various sales accounts associates contact information with a particular entity – i.e. that customer. – see also Upshot C page 1 para 1.

receiving, via the GUI, and storing information in the at least one searchable database regarding the quality of one or more contacts with the particular entity,

Art Unit: 3623

Upshot B page 1 para 2, contact updates to the database are reflected to the user regarding new deals, contact updates and account changes.

the one or more contacts comprising a module for reducing the size of data accessed in the at least one searchable database, the module arranged by at least one of a size and a geographic location,

Upshot A page 1 para 4, Upshot arranges a module by geography, or by territory, so that users can access only that data and not the entire sales workforce automation data for other or all the regions. This grouping reduces the size of the data since only one region is being examined.

the quality of one or more contacts being indicated by one of a set of specific guidelines required by the software application indicating the value of the contact to the sales representatives,

Upshot A page 1 para 3, the notification of 'hot new leads' indicates the value of the contact to sales representatives in that it indicates that a potential customer is a candidate to buy something.

the set of guidelines including at least an indication of whether the contact with the particular entity is for post-sale maintenance

Upshot A para 3, the tracking of support tasks includes an indication of whether a contact is for post-sale maintenance, since Upshot C page 1 para 3 indicates that "up to the minute status" on every deal is provided.

and an indication that a contact furthered future sales opportunities that could lead to additional business;

Art Unit: 3623

Upshot A page 1 para 5, the indication provided by the system generates a determination of which marketing campaigns generate the best leads, i.e. could lead to additional business,

receiving and storing information in the at least one searchable database, via the GUI, regarding the classification of the same one or more contacts

wherein information regarding quality was also received about the particular entity, the class of one or more contacts being indicated from a set of specific customer classes required by the software application including a proactive contact requiring a proactive sales effort, where customers classified as proactive are those where a sales representative initiated the contact with the customer

Upshot A page 1 para 2, contact information for a sales process are tracked and stored in a database – see Upshot D page 1 para 2, data about sales contacts can be added to the database via the sales person's GUI. Upshot A page 1 para 3, Immediate notification about contacts with regards to the quality of the contacts is received from a set of specific customer classes (i.e. a hot new leads versus other leads).

receiving proactive contact information, via the GUI, in a plurality of data fields in the at least one searchable database, the proactive contact information comprising customer account information, customer identification information, and quality contact type information, the quality

Art Unit: 3623

contact type information comprising at least one of customer visit information and customer telephone call information;

Upshot D page 1 para 2, the sales person's GUI allows them to update account information to the database. The examiner notes that the type of information being claimed as added to the database is nonfunctional descriptive material, because the receiving of data through data fields into a database are patentably the same regardless of the type of data claimed. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

tracking edits to the proactive contact information in at least one of the plurality of data fields including indicating when a last edit to the proactive contact information was made;

Upshot B page 1 para 2, changes to the account information including account changes and contact updates are tracked by the system.

generating at least one report associated with the proactive contact which is utilized to track sales activities, compare the performance of the one of the plurality of sales representatives with at least one established performance metric, and determine which of a plurality of entities should be contacted and in what order;

Art Unit: 3623

Upshot A page 1 para 2, the complete sales history is provided by the software. Since it is provided at a glance the examiner interprets this to meet the claimed limitation of a 'report'.

Upshot A page 1 para 4, the provision of a forecast is a kind of report, since it summarizes what is predicted; also viewing a pipeline by sales rep, territory or team are also reports that provide performance. see also para 5, a 'summary level' to details means that the 'summary level' is a summary report of the overall activity. The examiner notes that the use of the limitation "which is utilized to" indicates that the following limitations are intended use and not granted patentable weight.

receiving, electronically from a billing system, billing information associated with the particular entity in the at least one searchable database for review by the one of the plurality of sales representatives, wherein the billing information is associated with previously collected historical information associated with the one or more contacts and the one of the plurality of sales representatives

Upshot A page 1 para 1, Upshot teaches that account information (which is billing information in that it denotes a sales account, i.e. a customer account which identifies a customer who has purchased a product – note that sales history, i.e. the sales history associated with a customer is also viewable by the sales rep. Furthermore para 2 notes that accounts and contacts are tracked; Upshot D page 1 para 2, The sales representative has access to external

Art Unit: 3623

company resources (i.e. a billing system) for price list information (i.e. billing information) while using Upshot while travelling.

Upshot does not teach using a 'do not call' features as per:

determining whether the one or more contacts with the particular entity is classified as do not call, and if so, preventing the one or more contacts from being placed in a list comprising the proactive contact to prevent the one or more contacts from receiving solicitations from the one of a plurality of sales representatives;

Melchione et al. teach a sales and marketing support system using a central customer information system (CCIS) database with the feature of a promotional suppression facility that provides information on customers and non-customers who do not wish to be contacted by telephone and/or mail (title, col. 9, lines 13-29).

Melchione and Upshot address selling to customers through directed one on one contact from a sales person to the customer, thus both Melchione and Upshot are analogous art.

Melchione teaches that knowing the needs of the customer are important for a service provider to be effective in maintaining the relationship with that customer. Melchione notes that for a large organization with many customers, this becomes difficult, but can be managed through effectively managing the data associated with these customers.

One of ordinary skill in the art at the time of the invention would have modified the teachings of Upshot, regarding using a database to provide sales people in the field with the most current and up to date information so they can effectively interface with customers in the sales function, to include the step of ensuring the database maintains a 'do not call' note for specific customers, because it would ensure that the needs of the customers would be met by providing the sales person with this information.

Regarding **Claim 2**, Upshot teaches:

wherein the first item of contact information is received through a website.

Upshot D page 1 para 2, users can access account information on the road through a web application (i.e. through a website) see also Upshot A page 1 para 1, Upshot is a browser-based application, that is, it provides sales people information through a website.

Regarding **Claim 3**, Upshot teaches:

wherein the first item of contact information, the contact quality and the contact classification is received from different sales representatives.

Upshot A page 1 para 3, information related to sales accounts, leads and contacts is shared among the sales team (i.e. different sales representatives) to coordinate sales efforts. The examiner notes that the sharing of data meets the

Art Unit: 3623

claimed limitations as per the nonfunctional descriptive material discussed above, that is, the type of data being shared does not patentably distinguish the claim since the type of information does not impact the 'received from different sales representatives' functional limitation.

Regarding **Claim 4**, Upshot teaches:

wherein the first item of information, the contact quality and the contact classification are provided to a sales representative that did not provide any of the first item of information, the contact quality and contact classification information.

Upshot B page 1 para 2, changes to account information is provided to a sales representative, including, as per Upshot A page 1 para 3, information from others on the sales team, i.e., from other sales representatives and not from the sales rep receiving the information.

Regarding **Claim 5**, Upshot teaches:

wherein the entity is a business.

Upshot D page 1 para 3, Upshot refers to dealing with "customer's businesses" in the context of growing and evolving. Thus the entity being sold to is a business.

Regarding **Claim 6**, Upshot teaches:

Art Unit: 3623

wherein the first item of contact information is associated with a sales representative.

Upshot D page 1 para 2, sales representatives can access their particular account information, thus it is associated with them – see also Upshot A page 1 para 2, information being tracked is associated with a particular sales representative.

Regarding **Claim 9**, Upshot teaches:

wherein the GUI and printout include a follow up list.

Upshot B page 1 para 2, sales reps are provided with a follow-up list (i.e. a 'to-do' list). See also Upshot D page 1 para 2, the browser provides 'to-do' list items and appointments.

Regarding **Claim 10**, Upshot teaches:

wherein the follow up list is sorted chronologically.

Upshot D page 1 para 2, the browser provides 'to-do' list items and appointments (i.e. appointments are a follow-up list that are sorted chronologically, i.e. according to time).

Regarding **Claim 11**, Upshot teaches:

wherein sales representatives are automatically notified of appointed contacts.

Art Unit: 3623

Upshot D page 1 para 2, upon reconnection to the server, the sales person's calendar is automatically updated with appointments (i.e. they are automatically notified of appointed contacts).

Claims 23 and 30-32 recite similar limitations to those recited by the rejection of **Claims 2-6, 9-11 and 27** above, and are therefore rejected under the same rationale.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Charles, Erik et.al. "Tracking Sales Performance", March 2000, ACA news, pp.39-41, retrieved from the web at ;
http://segalsibson.com/publications/reprints/Tracking_Sales_Performance.pdf

Burt, Bob; "Symantec ACT! 4.0 for Windows 95", PC Update Online!, February 1999, PC Update: The magazine of the Melbourne PC User Group, retrieved from the web at:
<http://www.melbpc.org.au/pcupdate/9902/9902article10.htm>

Art Unit: 3623

Anonymous, "The 1996 Software Guide: Targeting and reaching the right customers more effectively, June 1996, Direct Marketing, Vol. 59, Iss. 2, p. 34, 12 pgs. ProQuest ID 9807739.

Johnson, Amy Helen; "Data warehousing", Dec 6, 1999, Computerworld, Framingham, Vol. 33, Iss. 49, p. 74, 1pgs., ProQuest ID 47013131.

Engle, Robert; et.al. "Sales force automation usage, effectiveness and cost benefit in Germany, England and the United States", 2000, The Journal of Industrial Marketing, Vol. 15, Iss. 4, pg. 216, ProQuest ID 115716829.

"SalesLogix Home Page", 1-25-1999 webpage of web.archive.org from salelogix.com, pp.1-2.

Anonymous, "Private Profiles: Upshot", June 22, 1998, Computer Letter, retrieved from web.archive.org webpage from upshot.com on Jan 28, 1999, pp.1-2.

"Upshot Sales System Requirements", 2-21-1999 webpage of web.archive.org from upshot.com, pp.1-2.

"Upshot Selection Guide", 1-20-1998 webpage of web.archive.org from upshot.com, p.1.

Art Unit: 3623

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan G. Sterrett whose telephone number is 571-272-6881. The examiner can normally be reached on 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JG

JGS 1-31-07

C. Michelle Tarac
C. Michelle Tarac
Primary Patent Examiner
Art Unit 3623